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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/403,329	10/26/2000	Paul Mueller	33900-56PUS	7124

7590 06/06/2002

Martin B Pavane  
Cohen Pontani Lieberman & Pavane  
Suite 1210  
551 Fifth Avenue  
New York, NY 10176

EXAMINER

SHIPSIDES, GEOFFREY P

ART UNIT	PAPER NUMBER
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1732

DATE MAILED: 06/06/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

21-12

**Office Action Summary**

Application No.

09/403,329

Applicant(s)

MUELLER ET AL.

Examiner

Geoffrey P. Shippides

Art Unit

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**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --****Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 15-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 15-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All   b) ☐ Some \*   c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 9, 10.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Priority***

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 25-29 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim 25 recites "an element interfaced with the magazine for expanding the flattened label", however, neither the claim nor the specification teaches how this element expands the label. The specification teaches that the label is "deformed and/or opened or expanded, e.g. by blowing thereby giving it again a shape that is close to its final shape", however this fails to teach how the label is expanded. Is the label stretched or is the label simply unflattened? Appropriate action is required, however the applicant is guarded against the insertion of new matter. Claims 26-29 are further dependent on claim 25.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 25-29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 25 recites "an element interfaced with the magazine for expanding the flattened label", however, it is unclear as to if the element is stretching the label or if the element is expanding the label in some other way such as unflattening the label. Clarification and/or correction is required, however, the applicant is guarded against the insertion of new matter. Claims 26-29 are further dependent on claim 25.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 15 and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,614,146 (Nakamura et al.).

Nakamura et al. teaches a method and apparatus for supplying labels to injection molds (title). Nakamura et al. teaches a process in which a label is supplied to an inner surface of a fixed die of an injection molding machine from a known label supply device

by air suction into the outer periphery of a pseudo core. The pseudo core (movable pneumatic gripping means) is pivotally moved from the supply and the label is then inserted into the opened fixed die and is stopped at a label delivering position. The label is supplied to an inner peripheral surface (label retaining part) of the fixed die by air supplied from the air supply device (Abstract). Figures 4 and 5 of Nakamura et al. show that the label is taken from a flat state to an unflattened state onto the pseudo core where the ends of the label are joined together prior to insertion of the label into a molding die. The pseudo core uses a vacuum to grip on to the label and used an air supply means to retain the label to the surface of the molding die and this constitutes a pneumatic gripping means. The pseudo core also constitutes a male portion of the mold.

8. Claims 15, 19, 20, and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Swiss-Liechtenstein Patent No. CH 638,718 A (Sandherr Max AG).

Sandherr Max AG teaches an injection molding method for a container (Page 2, Column 1, lines 2-3), provided with a packing label which is introduced into the mold (Page 2, Column 1, lines 3-4) prior to injection (Figure 2), wherein the label is shaped (Page 3, Column 2, lines 3-4) and at least two edges of said label are attached to each other (Page 3, Column 1, line 67), so that the shaped label is transferred and placed on a male die (6) of the mold (Page 2, Column 1, lines 57-63) by a movable transfer means (Figure 4, reference signs 46,48,50,52; Page 3, lines 35-36). It is inherent that the movable transfer means taught by Sandherr Max AG constitutes a movable gripping means because in order to transfer the label the transfer means must grip the label.

Figure 5 of Sandherr Max AG shows a method wherein the label (16) is transferred to the mould (56), the shaped and expanded label is engaged about a die of the mould (6), and the label is thereafter placed in its final position about the die (in position 58) by a push member (50,52). According to a particular embodiment, the guide means (46,48) are axially movable in relation to the die in order to place the label on the latter (Page 3, Column 2, lines 35-38). This push member constitutes a thrusting member.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 18, 21, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Swiss-Liechtenstein Patent No. CH 638,718 A (Sandherr Max AG) in view of admitted prior art (Admission).

The discussion of Sandherr Max AG above applies herein.

With regard to claim 18, it is well known in the art of molding to simultaneously mold multiple articles in a single molding operation and also to provide for multiple identical mold parts to allow for the simultaneous molding of multiple articles simultaneously. It would have been obvious to one having ordinary skill in the art at the time of invention to have provided for multiple sections on a gripping means for the collection of labels and to collect multiple labels simultaneously in order to allow for the

molding of multiple labeled articles as is well known in the art by the method as taught by Sandherr Max AG in order to speed up the production cycle of labeled articles.

With regard to claims 21 and 22, it is well known in the art to make labels out of a variety of materials, including paper and polypropylene and is admitted prior art (Page 2, lines 3 and 4 of the instant specification). It would have been obvious to one having ordinary skill in the art at the time of invention to use the method as taught by Sandherr Max AG with labels made out of any well known label material including paper and polypropylene in order to produce articles with a label type of choice.

11. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Swiss-Liechtenstein Patent No. CH 638,718 A (Sandherr Max AG) in view of U.S. Patent No. 5,614,146 (Nakamura et al.) and admitted prior art (Admission).

The discussions of Sandherr Max AG and Nakamura et al. above apply herein.

With regard to claim 16, Sandherr Max AG does not specifically teach that the gripping means is of pneumatic gripping means. Pneumatic means of gripping are well known in the art and Nakamura et al. teaches a pneumatic means for gripping a label before transferring the label to the mold. Sandherr Max AG also does not teach a thickness of the label being less than 50 microns. Admission, however, teaches that labels in this thickness range are known in the art (Page 4, lines 10-12 of the instant specification). It would have been obvious to one having ordinary skill in the art at the time of invention to use a label having less than 50 microns as are well known in the art and taught by Admission in the method as taught by Sandherr Max AG in order to produce labeled containers with the label material savings associated with labels having

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a thickness less than 50 microns. It would have been further obvious to one having ordinary skill in the art at the time of invention to use a pneumatic means as taught by Nakamura et al. for gripping a label by the transfer means as taught by Sandherr Max AG for transferring the label to the male part of a mold prior to injection molding a container with a label in order to reduce the process time by directly inserting the label into the female mold upon the closing of the mold. It would have been further obvious to one having ordinary skill in the art to use the pneumatic gripping means as taught by Nakamura et al. in association with a label having a thickness less than 50 microns as taught by Admission in order to allow for easy gripping of a label having such a thickness than would be allowed for by non-pneumatic means.

12. Claims 17 and 24, 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Swiss-Liechtenstein Patent No. CH 638,718 A (Sandherr Max AG) in view of U.S. Patent No. 5,614,146 (Nakamura et al.), U.S. Patent No. 3,602,496 (Langenohl), U.S. Patent No. 6,159,568 (Freedman et al.), U.S. Patent No. 4,986,866 (Ohba et al.), and U.S. Patent No. 4,992,038 (Furuse et al.).

The discussions of Sandherr Max AG and Nakamura et al. above apply herein.

With regard to claims 17 and 24, neither Sandherr Max AG nor Nakamura et al. teach that the label is taken from a magazine. Nakamura et al. teaches that the labels are taken from a known supply device in a flat state then transferred to a non-flattened state prior to transferring the label to the mold (Figures 4 and 5). It is well known in the art to supply labels in stacks in magazines, and to extract the label from the magazine in order to supply the label to a mold. Langenohl, Freedman et al., Ohba et al., and



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Furuse et al. are cited merely to demonstrate that it is known in the art to supply labels in stacks in magazines. It would have been obvious to one having ordinary skill in the art at the time of invention to provide the labels to the process of Sandherr Max AG by magazine as is well known in the art to facilitate the process of feeding labels to the gripping means.

With regard to claim 25, Sandherr Max AG teaches an expanded label.

Nakamura et al. teaches a process of unflattening a label from a flattened state from a known label supply device using pneumatic means. The pseudo core as taught by Nakamura et al. constitutes an element for expanding the flattened label that contacts an outside face of the label (Figure 4). It would have been obvious to one having ordinary skill in the art at the time of invention to use an pneumatic means to unflatten and expand a label from a known supply device as taught by Nakamura et al. in order to retrieve labels and have the labels in a unflattened expanded form as taught by Sandherr Max AG in the process of Sandherr Max AG in order to provide a method for easily retrieving labels.

With regard to claims 26 and 27, it is well known in the art of molding to simultaneously mold multiple articles in a single molding operation and also to provide for multiple identical mold parts to allow for the simultaneous molding of multiple articles simultaneously. It would have been obvious to one having ordinary skill in the art at the time of invention to have provided for multiple sections on a gripping means for the collection of labels and to collect multiple labels simultaneously in order to allow for the

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molding of multiple labeled articles as is well known in the art by the method as taught by Sandherr Max AG in order to speed up the production cycle of labeled articles.

With regard to claim 28, it is well known in the art to use robots to move transport elements in all directions in order to allow for precise movement. It would have been obvious to one having ordinary skill in the art at the time of invention to use a robot to move the transfer element as taught by Sandherr Max AG in order to allow for precise movement of the transfer element to the male mold part.

With regard to claim 29, Figure 5 of Sandherr Max AG shows a method wherein the label (16) is transferred to the mould (56), the shaped and expanded label is engaged about a die of the mould (6), and the label is thereafter placed in its final position about the die (in position 58) by a push member (50,52). According to a particular embodiment, the guide means (46,48) are axially movable in relation to the die in order to place the label on the latter (Page 3, Column 2, lines 35-38). This push member constitutes a thrusting member.

13. Claims 15, 16, and 18-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,614,146 (Nakamura et al.) in view of Swiss-Liechtenstein Patent No. CH 638,718 A (Sandherr Max AG).

The discussions of Nakamura et al. and Sandherr Max AG above apply herein.

With regard to claims 15, 20, and 23, even if Nakamura et al. does not teach the placement of the shaped label onto a male portion of the mold, Sandherr Max AG does teach the placement of the shaped label on to a male portion of a mold. It would have been obvious to one having ordinary skill in the art at the time of invention to modify the

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process as taught by Nakamura et al. to place the formed label on to the male portion of the mold for introducing the label into the mold cavity as taught by Sandherr Max AG in order to speed up the molding process by eliminating the step of placing one of the two cores (the pseudo core and the male molding die) into the female die by having the male mold part directly place the label into the mold as taught by Sandherr Max AG. Sandherr Max AG also teaches the edges of the label are glued together. So even if Nakamura et al. does not specifically teach that the ends of the label are attached together, it would have been obvious to one having ordinary skill in the art at the time of invention to glue the edges of the label together as taught by Sandherr Max AG in order to ensure that the edges of the label do not separate during the injection molding process.

With regard to claim 16, Nakamura et al. teaches a pneumatic gripping means. Nakamura et al. does not teach a thickness of the label, however, labels are known in the art to have a thickness range including less than 50 microns and it would have been obvious to one having ordinary skill in the art at the time of invention to use the method as taught by Nakamura et al. for a label of any thickness including labels having a thickness of less than 50 microns in order to provide a method for labeling injection molded articles with labels of less than 50 microns. It is further noted that it would have been further obvious to one having ordinary skill in the art at the time of invention to modify the gripping means as taught by Nakamura et al. to supply the label to the male molding die in order to allow the label to be supplied to the mold cavity upon closing of

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the mold cavity thus eliminating the step of placing the shaped label in to the female die prior to the closing of the mold.

With regard to claims 18, it is well known in the art of molding to simultaneously mold multiple articles in a single molding operation and also to provide for multiple identical mold parts to allow for the simultaneous molding of multiple articles simultaneously. It would have been obvious to one having ordinary skill in the art at the time of invention to have provided for multiple sections on a gripping means for the collection of labels and to collect multiple labels simultaneously in order to allow for the molding of multiple labeled articles as is well known in the art by the method as taught by Nakamura et al. in order to speed up the production cycle of labeled articles.

With regard to claims 19, Figure 5 of Sandherr Max AG shows a method wherein the label (16) is transferred to the mould (56), the shaped and expanded label is engaged about a die of the mould (6), and the label is thereafter placed in its final position about the die (in position 58) by a push member (50,52). According to a particular embodiment, the guide means (46,48) are axially movable in relation to the die in order to place the label on the latter (Page 3, Column 2, lines 35-38). It would have been obvious to one having ordinary skill in the art at the time of invention to use this method to transfer the shaped label as taught by Sandherr Max AG in process as taught by Nakamura et al. in order to move the shaped label from the pseudo core to the male die in order to speed up the molding operation by avoiding the need to place the label into the female die by simultaneously placing the label into the cavity upon closing the mold cavity by placing the shaped label on to the male molding die.

With regard to claims 21 and 22, it is well known in the art to make labels out of a variety of materials, including paper and polypropylene. It would have been obvious to one having ordinary skill in the art at the time of invention to use the method as taught by Nakamura et al. and Sandherr Max AG with labels made out of any well known label material including paper and polypropylene in order to produce articles with a label type of choice.

14. Claims 17 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,614,146 (Nakamura et al.) in view of Swiss-Liechtenstein Patent No. CH 638,718 A (Sandherr Max AG) as applied to claims 15, 16, and 18-23 above, and further in view of U.S. Patent No. 3,602,496 (Langenohl), U.S. Patent No. 6,159,568 (Freedman et al.), U.S. Patent No. 4,986,866 (Ohba et al.), and U.S. Patent No. 4,992,038 (Furuse et al.).

With regard to claims 17 and 24, Nakamura et al. teaches the label is taken from a known label supply device. Nakamura et al. teaches that the labels are in a flat state then transferred to a nonflat state prior to transferring the label to the mold (Figures 4 and 5). It is well known in the art to supply labels in stacks in magazines, and to extract the label from the magazine in order to supply the label to a mold. Langenohl, Freedman et al., Ohba et al., and Furuse et al. are cited merely to demonstrate that it is known in the art to supply labels in stacks in magazines. It would have been obvious to one having ordinary skill in the art at the time of invention to provide the labels to the process of Nakamura et al. by magazine as is well known in the art to facilitate the process of feeding labels to the gripping means as taught by Nakamura et al.

### ***Conclusion***

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. U.S. Patent No. 3,559,248 (Stockmann), U.S. Patent No. 4,725,327 (Matuda et al.), U.S. Patent No. 5,520,876 (Dobler), U.S. Patent No. 5,919,414 (Dobler), U.S. Patent No. 5,925,208 (Dronzek, Jr.), U.S. Patent No. 6,007,759 (Ten Tije et al.), U.S. Patent No. 6,264,876 B1 (Ballay), European Patent No. 331,596 A2 (Stein-Teyssandier), European Patent Application No. EP 0,546,234 A1 (Gladys), Japanese Patent No. JP 05285981 A (Nakamura et al.), and Japanese Patent No. JP 06270198 A (Okuno et al.) are cited as art of interest to show the current state of the art at the time of invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Geoffrey P. Shipsides whose telephone number is 703-306-0311. The examiner can normally be reached on Monday - Friday 9 AM till 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jan H Silbaugh can be reached on 703-308-3829. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

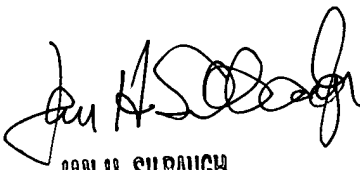
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Geoffrey P. Shipsides/gps

May 31, 2002

  
JAN H. SILBAUGH  
SUPERVISORY PATENT EXAMINER  
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05/31/02